

U.S. Patent No. 09/858,172  
Reply to Office Action dated December 1, 2005

PATENT  
450100-03223

REMARKS

In light of the above amendatory matter and remarks to follow, reconsideration and allowance of this application are respectfully solicited.

It is instructive to recall the prosecution of this application. In the first Office Action dated October 19, 2004, the Examiner rejected the claims on the ground of double patenting. The Examiner also alleged that the applicant did not invent the subject matter claimed in this application. In reply, the double patenting rejection was traversed; and applicant submitted a Declaration stating that he was the sole inventor of the claimed subject matter.

The Examiner repeated her double patenting rejection in the Final Office Action dated April 6, 2005; but she withdrew her contention that Applicant did not invent the subject matter claimed in this application. Once again, the double patenting rejection was traversed.

The Examiner withdrew her double patenting rejection and issued a non-final Office Action on June 16, 2005, rejecting all of the claims as being obvious in view of the patent upon which the Examiner had based her double patenting rejection. In reply, applicant invoked the benefit of 35 USC 103(c) to disqualify the use of that patent to reject applicant's claims on the ground of obviousness.

The Examiner withdrew her previous rejection; and the instant Office Action resulted.

Although there were three previous Office Actions; and although the Examiner presumably considered the claim language carefully, she rejected the claims, for the first time, under 35 USC 112. Applicant's attorney disagrees with the Examiner's rejection and maintains the claims are clear and unambiguous and are in full compliance with 35 USC 112, second

U.S. Patent No. 09/858,172  
Reply to Office Action dated December 1, 2005

PATENT  
450100-03223

paragraph. Nevertheless, to expedite the prosecution of this application to its successful conclusion, cosmetic changes in form are made to "streamline" the language used in the claims.

The Examiner rejects claim 5 because this claim states that the means is "charge processing means." This refers to the "charge processing means" of claim 1, to which the Examiner properly did not object.

Similarly, the Examiner rejects claim 9 because this claim states that the "means" mentioned therein is "transmitting means." This refers to the "second transmitting means" of claim 6, to which the Examiner properly did not object.

The Examiner contends that any adjective placed before the word "means" in a claim is prohibited by 35 USC 112, sixth paragraph; and she refers to Ex part Klumb, 159 USPQ 694. However, in Klumb, the claim simply referred to "wing means" and "plate means," and no function performed by such means was recited. The lack of function was the basis for the Board's affirmation of the Examiner's rejection in Klumb. This is in stark contrast to applicant's claims 5 and 9 which clearly recite the functions performed by the "charge processing means" of claim 5 and the "transmitting means" of claim 9. Therefore, unless the Examiner is aware of authority that prohibits the use of adjective modifiers in "means plus function" recitations, she is respectfully requested to withdraw her rejection of claims 5 and 9 under 35 USC 112.

Claim 1 was rejected because there is allegedly insufficient antecedent basis for "the information" recited in paragraphs 2 and 4 of the claim. Paragraph 2 recited,

"storing means for storing the information which is entered by said registered party about said right and which is received by said first receiving means."

It is clear that the information stored by the storing means is the information received by the first receiving means. Such stored information is the "rights" information; and claim 1 is amended to

U.S. Patent No. 09/858,172  
Reply to Office Action dated December 1, 2005

PATENT  
450100-03223

use this shorthand notation. That is, as amended, claim 1, paragraph 2 states that the storing means stores the rights information.

Paragraph 4 of claim 1 recited,

"second receiving means for receiving information transmitted by a reader concerning possible infringement on said right."

It is clear that the information received by the second receiving means is information from a reader, which information concerns possible infringement on the right held by a registered party. This information is infringement-related information; and claim 1 is amended to use this shorthand notation and now recites that the second receiving means receives infringement-related information.

Other similar amendments are made to several of the remaining claims. Consequently, the withdrawal of the rejection of the claims under 35 USC 112 is respectfully requested. Should the Examiner have specific objections to particular language used in the claims, she is invited to identify such allegedly objectionable language.

Claims 1-4, 6-10 and 12 are rejected under 35 USC 103 as allegedly obvious in view of U.S. Patent 6,289,341 (Barney) taken with U.S. Patent 5,862,260 (Rhoads). Claims 5 and 9 were rejected as being obvious over the combination of Barney and Rhoads, with the addition thereto of the Ferziger article. It is respectfully submitted, claims 1, 6 and 12, all the independent claims in this application, are unobvious over the combination of Barney and Rhoads, and the addition thereto of Ferziger fails to cure the defects of Barney and Rhoads.

Barney is directed to an automatic "intelligent agent" that uses a web browser to surf internet sites and compare data retrieved from a surfed site to keywords representing IP indicia stored in a database to detect a site that possibly describes a potentially infringing device. In applying Barney to the claims, the Examiner contends that Barney "mak[es] information

U.S. Patent No. 09/858,172  
Reply to Office Action dated December 1, 2005

PATENT  
450100-03223

public," as described at column 2, lines 18-21 of Barney. Neither this portion nor any portion of Barney suggests that information is made public. In any event, Barney fails to suggest claim limitations found in applicant's claims -- and the Examiner recognizes this deficiency of Barney, as evidenced by her refusal to contend that Barney anticipates applicant's claims.

Barney does not describe or suggest,

"first receiving means for receiving ... charge processing information for charge processing with regard to said registered party."

Nor does Barney describe or suggest,

"transmitting means for readably transmitting to the general public the rights information stored in said storing means with regard to said right held by said registered party."

Barney accesses a web site, retrieves data from that accessed site and compares the retrieved data to an IP database. It is an unwarranted misinterpretation of Barney to construe this function as "readably transmitting to the general public the rights information stored in said storing means." Barney transmits nothing to a surfed website, much less readable rights information.

Continuing with claim 1, Barney does not describe or suggest,

"second receiving means for receiving infringement-related information transmitted by a reader concerning possible infringement on said right."

Barney is unconcerned with a reader (i.e. one who reads). The data retrieved from a surfed website by Barney is not "infringement-related" information ... concerning possible infringement."

Finally, Barney does not describe or suggest,

"charge processing means for effecting charge processing regarding said registered party based on the charge processing information received by said first receiving means with respect to said registered party."

U.S. Patent No. 09/858,172  
Reply to Office Action dated December 1, 2005

PATENT  
450100-03223

The Examiner recognizes that Barney fails to suggest charge processing. Rhoads is relied upon for this alleged teaching. The Examiner contends, "Rhoads teaches the identifying the process [sic] of selling (charging) the material used by another." It is not clear how the Examiner is interpreting Rhoads; but notwithstanding that interpretation, it is clear Rhoads has nothing to do with the "charge processing means" or the function of the charge processing means defined by applicant's claim 1. Rhoads is concerned with detecting both authorized and unauthorized works (e.g. software, pictures, audio, video, and other copyrightable material) on the internet (see Rhoads' Abstract). Rhoads "monitor[s] internet dissemination of various properties, and report[s] the results back to their proprietors" (col. 1, lines 29-31). Rhoads uses watermarks on authorized copies of material to detect an unauthorized copy or to trace the trail of those copies (Fig. 3; col. 25, lines 19-29). It simply does not follow, and one of ordinary skill in the art will not understand from Rhoads, that this reference teaches the aforequoted charge processing recitation of claim 1. Thus, even if Barney and Rhoads could be combined (applicant objects to this attempted combination of disparate and unrelated references), the result still fails to teach all of the recitations found in claim 1.

It is improper to attempt to combine Barney and Rhoads. One who reads and understands Barney would be neither encouraged nor motivated to use Rhoads' copy-trailing technique. The suggestion to combine these references must come from the references themselves, not from the recognition gleaned from applicant's disclosure of the possible desirability to combine. See In re Laskowski, 10 USPQ 2d, 1397, 1399 (Fed. Cir. 1989). There is no objective teaching in the prior art that would lead one to combine the teachings of Rhoads with the teachings of Barney as proposed by the Examiner. Without such objective teaching, it is erroneous to reject claim 1. In re Fritch, 23 USPQ 2d 1780, 1783 (Fed. Cir. 1992); In re Bond,

U.S. Patent No. 09/858,172  
Reply to Office Action dated December 1, 2005

PATENT  
450100-03223

15 USPQ 2d 1566, 1568 (Fed. Cir. 1990); In re Fein, 5 USPQ 2d 1596, 1598 (Fed. Cir. 1988).

The established authorities have reversed obviousness rejections based upon a combination of references that do not themselves suggest the combination.

Therefore, the rejection of claim 1 as being obvious in view of the combination of Barney and Rhoads is unwarranted and should be withdrawn.

Claim 6 is similar to claim 1 and the rejection of claim 6 should be withdrawn for the same reasons noted above. Claim 6 recites the "first receiving means," the "first transmitting means" and the "second receiving means" recited in claim 1. Claim 6 also recites, "second transmitting means for notifying a charge processing organization to effect charge processing regarding said registered party." As mentioned above, neither Barney nor Rhoads is concerned with charge processing, and neither reference suggests the aforementioned second transmitting means that notifies a charge processing organization to effect charge processing regarding the registered party.

Claim 12 is directed to a method "for allowing a registered party to register with a server a right ... in order to solicit information from readers reading about said right." Neither Barney nor Rhoads is even remotely concerned with allowing a party to register a right to solicit information from readers who read about that right.

Claim 12 further recites, "transmitting readable to the general public information about said registered right." This recitation is similar to that found in claim 1; and as was the case with claim 1, Barney does not suggest this function. Rhoads is silent with respect to transmitting readable information to the general public about the right that has been registered.

Claim 12 continues by reciting, "receiving information transmitted by a reader concerning possible infringement on said registered right." As discussed with respect to claim 1,

U.S. Patent No. 09/858,172  
Reply to Office Action dated December 1, 2005

PATENT  
450100-03223

Barney does not suggest that a reader should transmit information concerning possible infringement on the right about which information had been sent to that reader and, thus, there is no suggestion of receiving such information from a reader. Rhoads, which is relied upon by the Examiner for a totally different reason, does not cure this deficiency.

Finally, claim 12 recites, "notifying a charge processing organization to perform charge processing to have a contingent fee paid by said registered party if said registered party gains benefits from said right through the use of the infringement-related information provided by said reader." The Examiner agrees that Barney does not describe or suggest anything to do with charge processing. As pointed out above in connection with claim 1, neither does Rhoads.

Therefore, claim 12 is patentably distinct over the combination of Barney and Rhoads because one of ordinary skill in the art, after reading and understanding both references, would not be enabled thereby to carry out the method defined by claim 12.

Claims 2-5 depend from claim 1 and claims 7-11 depend from claim 6. Since the dependent claims include all of the limitations recited by the independent claim from which they depend, it follows that claims 2-5 and 7-11 are patentably distinct and, thus, allowable, over the combination of Barney and Rhoads. The addition of Ferziger to this combination fails to supply those elements that are missing from the Barney-Rhoads combination. Consequently, even if Ferziger is considered, one of ordinary skill in the art still would not be enabled to make and use the invention defined by applicant's dependent claims.

It is respectfully submitted that claims 1-12, all the claims present in this application, are in condition for allowance. Early notice to this effect is respectfully requested.

Statements appearing above in respect to the disclosures in the cited references represent the present opinions of the undersigned attorney, and, in the event the Examiner

U.S. Patent No. 09/858,172  
Reply to Office Action dated December 1, 2005

PATENT  
450100-03223

disagrees with any of such opinions, it is respectfully requested that the Examiner specifically indicate those portions of the references providing the basis for a contrary view.

Please charge any additional fees that may be needed, and credit any overpayment, to our Deposit Account No. 50-0320.

Respectfully submitted,

FROMMER LAWRENCE & HAUG LLP

By:

  
William S. Frommer  
Reg. No. 25,506  
(212) 588-0800